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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,577	03/08/2001	Joseph Damon Beaven	LE9-00-081	7775
21972	7590	06/13/2006	EXAMINER	
LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			VU, KIEU D	
		ART UNIT	PAPER NUMBER	
		2173		
DATE MAILED: 06/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/802,577	BEAVEN ET AL.	
	Examiner Kieu D. Vu	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 December 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-36 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-36 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 20-27, and 31 are rejected under 35 U.S.C. 101 because of the followings reasons:

Regarding claims 1-4 and 27, the “operating system” as claimed is a collection of software per se that is not implemented in or include any computer hardware component. As such, the claims are directed to non-functional descriptive material.

Regarding claims 20-26 and 31, the “computer program product in a computer readable medium” as claimed are not limited to tangible embodiments. In view of Applicant's disclosure at page 9, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., recordable type medium) and intangible embodiments (e.g., transmission type media). As such, the claims are solely directed to a form of energy per se and are not limited to statutory subject matter and are therefore non-statutory. See State Street, 149 F.3d at 1374-75, 47 USPQ2d at 1602 (Fed. Cir. 1998) (MPEP 2106)

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2173

3. Claims 7-19, 28-30, and 32-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7, 12, 16, and 32 contain the trademark/trade name (see line 1 of each claim). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a type of "environment" and, accordingly, the identification/description is indefinite.

Claims 8-11, 13-15, 17-19, 28-30, and 33-36 are rejected with the same reason.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki and Sieffert (USP5630101).

Regarding claims 1 and 20, Suzuki teaches an operating system for managing data in a computer, comprising the generating a GUI for a printer for interfacing between a host processor of the computer and a user (column 1, lines 46-49); a data module containing an operating code for causing the printer to execute a predetermined action responsive to a computer command initiated at the GUI (Fig. 1, column 6, lines 38-43); and a conflict dialog module coupled to the data module and having a list of conflicts, the data module causing the conflict dialog module to generate a conflict (error) from the list of conflicts responsive to a selected predetermined action to be executed by the host processor (col 2, lines 6-8; col 5, lines 52-64). Sieffert does not teach that the modification does not affect the list of conflicts. However, such feature is known in the art as taught by Sieffert. Sieffert teaches an imaging system in which each component is a discrete software object a “black box” (col 9, lines 50-61) such that each component can be modified or replaced without affecting the performance of the others (see Fig. 1; line 60 of col 2, to line 20 of col 3). It would have been obvious to one of ordinary skill in the art, having the teaching of Suzuki and Sieffert before him at the time the invention was made, to modify the printing system taught by Suzuki to include black box design taught by Sieffert so that each component of the system can be modified or redesigned with minimized impact to the overall system (Sieffert, col 3, lines 13-20).

Regarding claims 7 and 16, Suzuki teaches an operating system for managing data in a computer, comprising the generating a GUI for a printer for interfacing between a host processor of the computer and a user (column 1, lines 46-49); a data module containing an operating code for causing the printer to execute a predetermined

action responsive to a computer command initiated at the GUI (Fig. 1, column 6, lines 38-43); and a conflict dialog module coupled to the data module and having a list of conflicts, the data module causing the conflict dialog module to generate a conflict (error) from the list of conflicts responsive to a selected predetermined action to be executed by the host processor (col 2, lines 6-8; col 5, lines 52-64). Sieffert does not teach that the printer properties main dialog module, the printer data module and the conflict dialog module are independently modifiable, such that one of the modules may be modified without affecting at least one of the other modules. However, such feature is known in the art as taught by Sieffert. Sieffert teaches an imaging system in which each component is a discrete software object a “black box” (col 9, lines 50-61) such that each component can be modified or replaced without affecting the performance of the others (see Fig. 1; line 60 of col 2, to line 20 of col 3). It would have been obvious to one of ordinary skill in the art, having the teaching of Suzuki and Sieffert before him at the time the invention was made, to modify the printing system taught by Suzuki to include black box design taught by Sieffert so that each component of the system can be modified or redesigned with minimized impact to the overall system (Sieffert, col 3, lines 13-20).

Regarding claims 12 and 32, Suzuki teaches an operating system for managing data in a computer, comprising the generating a GUI for displaying data for a printer in operative communication with a host processor of the computer and a user, from a GUI code included in a printer properties main dialog module (column 1, lines 46-49); a printer data module containing an operating code for causing the printer to execute a

predetermined action responsive to a computer command initiated at the GUI (Fig. 1, column 6, lines 38-43); and a conflict dialog module coupled to the data module and having a list of conflicts, the data module causing the conflict dialog module to generate a conflict (error) from the list of conflicts responsive to a selected predetermined action to be executed by the host processor (col 2, lines 6-8; col 5, lines 52-64). Sieffert does not teach that the printer properties main dialog module, the printer data module and the conflict dialog module are independently modifiable, such that one of the modules may be modified without affecting at least one of the other modules. However, such feature is known in the art as taught by Sieffert. Sieffert teaches an imaging system in which each component is a discrete software object a “black box” (col 9, lines 50-61) such that each component can be modified or replaced without affecting the performance of the others (see Fig. 1; line 60 of col 2, to line 20 of col 3). It would have been obvious to one of ordinary skill in the art, having the teaching of Suzuki and Sieffert before him at the time the invention was made, to modify the printing system taught by Suzuki to include black box design taught by Sieffert so that each component of the system can be modified or redesigned with minimized impact to the overall system (Sieffert, col 3, lines 13-20).

Regarding claims 2-4, 8-11, 13-15, 17-19, 21-24, 34-36, in Sieffert, modification of one component does not affect other components (col 3, lines 13-20).

Regarding claim 5, Suzuki teaches at least one peripheral device (printer 3) is coupled to the host processor 1 (Fig. 1).

Regarding claims 6 and 25, Suzuki teaches that the one peripheral device is a printer 3 (see Fig. 1).

Regarding claim 26, Suzuki and Sieffert do not teach that the device is a copy machine. However, since both printer and copy machine are used in reproduction environment, it would have been obvious for one of ordinary skill in the art to apply Suzuki and Sieffert method in a copy machine with the motivation being to apply the use of independent modification in a copy machine.

Regarding claims 27-31, 33, Suzuki, as modified by Sieffert, teaches one of the main dialog module, the data module or the conflict dialog module are independently modifiable such that one of the modules can be modified without affecting either of the other modules (Sieffert, col 9, lines 50-61) (see Sieffert, Fig. 1; line 60 of col 2, to line 20 of col 3).

6. Applicant's arguments filed 12/13/04 have been considered but they are not persuasive.

Applicant argues that Suzuki does not disclose or suggest a list of conflicts of the type displayed by the claim invention wherein a conflict corresponds to both a condition of the printer and an action to be executed by the printer. The Examiner respectfully disagrees. Suzuki teaches that an error (conflict) is from a list of errors (see "opening of a printer cover", "depletion of paper", "depletion of toner", col 13, lines 53-63) wherein an error (conflict) corresponds to both a condition of the printer (opening of a printer cover/depletion of paper/depletion of toner) and a selected predetermined action to be executed by the printer (print action to be executed by the printer) (see Fig. 6).

Applicant argues that neither Sieffert nor Suzuki discloses utilizing an independently modifiable module for GUI code. Sieffert has no discussion of a user interface at all." The Examiner respectfully disagrees since the argument attacks the references individually. Suzuki teaches GUI code but does not teach that each module can be modified independently. Sieffert teaches a technique wherein each software component or module can be modified or replaced without affecting the performance of other software components or modules (see Fig. 1; line 60 of col 2, to line 20 of col 3).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that it would not been obvious to combine the teachings of Suzuki and Sieffert. The Examiner disagrees. Since both Suzuki and Sieffert teachings are directed to processing image information, it would have been obvious to one of ordinary skill in the art, having the teaching of Suzuki and Sieffert before him at the time the invention was made, to modify the printing system taught by Suzuki to include black box design taught by Sieffert so that each component of the system can be modified or redesigned with minimized impact to the overall system (Sieffert, col 3, lines 13-20).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 571-272-4048.

Art Unit: 2173

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

and / or:

571-273-4057 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kieu D. Vu

Primary Examiner